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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,288	02/08/2001	George A. Huff JR.	37,248-03	6599
4249	7590	11/20/2003	EXAMINER	
CAROL WILSON BP AMERICA INC. MAIL CODE 5 EAST 4101 WINFIELD ROAD WARRENVILLE, IL 60555			MEDLEY, MARGARET B	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,288

Applicant(s)

HUFF ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,7,8,11-13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,11-13 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This action is in response to applicants' amendment dated July 28, 2003.

The amendments to the specification at pages 11 and 12, the amendments to claims 3-5 and 7-8, the adding of claims 23-27 and the cancellation of claims 1-2, 6, 9-10 and 14 have been entered of record. The pending claims of record are claims 3-5, 7-8, 11-13 and 15-27. Claims 15-22 have been withdrawn from consideration as directed to the non-elected invention. Applicant did not abandon the invention directed to Group II directed to claims 15-22. The Group II claims 15-22 are withdrawn from consideration as being directed to the non-elected invention.

The objection to the specification are withdrawn in view of applicants amendments made of record to the disclosure and claims correcting the examiner objection to the following informalities: The "R" substitute on each of the formula appearing on pages 11 and 12 of the instant application should be corrected to read as R¹ to be consistent with the definition for R¹ appearing in line 1 after the formula on page 12 of the instant application. Appropriate correction is required.

The objection to claim 14 is withdrawn for the following informalities: In line 1 after the formula, the R¹ definition is in conflict with the R substituent appearing in the claim 14.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 11 –12, 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 (and dependent claim 12) depends from claim 10 that has been canceled and therefore is indefinite. However in the interest of compact prosecution, claim 10 (and dependent claim 12 will be treated on the merits as depending from claim 26 as indicated on page 14 of the amendment dated July 28, 2003. Applicants are required to clarify the record as to the proper dependency of claims 11 and 12.

Claims 25 is confusing and unclear for the phrase "Type II and Type" and may be overcome with the inclusion of the formulas found on page 11 of the specification.

Claim 27 is confusing and unclear for the phrase "Type II" and may be overcome with the inclusion of the formula found on page 11 of the specification for clarity.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23, 3 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0,905,217 A (NIPPON OIL CO. LTD that teaches a composition for fuel or blending component of fuels comprising a liquid organic distillates having < 15 ppm sulfur and at least about 0.2 – about 20% oxygen as organic compounds, wherein the said organic oxygens added to the organic distillate is greater than 10⁰ C of the initial boiling point of

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the distillate, the fuel comprises additional fuel additives and the organic distillate is a mixture of organic compounds derived from natural petroleum, page 10, line 28 – page 10 line 39; tables 1 and 2, that anticipates the instant claims. The examiner takes the position that the newly added formula is an inherent property since the oxygen proportional of the prior art is the same as the instant claims.

Claims 23 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipates by Berlowitz et al (Berlowitz) 5,807,413 A that teaches a composition for fuel or blending component of fuels comprising a liquid organic distillates having < 15 ppm sulfur and at least about 0.2 – about 20% oxygen as organic compounds wherein the said organic distillates contain 5 to about 15 carbon atom of which at least about 85% are normal alkenes, column 1, line 26 to column 1, line 53, that anticipates the instant claims. The examiner takes the position that the newly added formula is an inherent property since the oxygen proportional of the prior art is the same as the instant claims.

Claims 24, 7-8 and 26-27, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz 5,807,413 A as applied to claims 1 and 4 above, and further in view of Berlowitz 5,807,413 A in view of Taylor 47,923,963 and Davies et al (Davies) 6,010,545.

Applicants further teaches the fuel having flash points (FP) of at least 38⁰ C or 49⁰ C further additives of cold flow improvers and the oxygen being of cyclic benzylic ketones.

Berlowitz further teaches diesel fuel having FP of 140⁰ F and < 100⁰ F, Table 3 of column 4, that reads on the instant claimed FP of at least 38⁰ C or 49⁰ C.

Taylor teaches diesel fuel having oxygenated cyclic benzylic lactones, note column 6 at Table I for fluororenone and other lactone compounds providing the motivation for adding the cyclic benzylic ketones in Berlowitz fuels with the reasonable expectation that the additive will impart its oxygenate properties in the fuel that render the instant claims obvious. The examiner takes the position that the newly added formula is an inherent property since the oxygen proportional of the prior art is the same as the instant claims.

Davis teaches and discloses diesel fuel comprising flow improvers, column 6, lines 33 to column 10, lines 58, especially column 8, lines 20-47 providing the motivation for adding the additive to the fuel of Berlowitz with the reasonable expectation of imparting its flow properties to the fuel that render the instant claims obvious. The examiner takes the position that the newly added formula is an inherent property since the oxygen proportional of the prior art is the same as the instant claims.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 905 217 A Nippon Oil Co. Ltd. as applied to claims 1-3 and 5 above, and further in view of EP 905 217 A Nippon Oil Co. Ltd.

Applicant further claims Reid vapor pressure (RVP) of at least 6 psi.

EP '217 further teaches that the RVP should be less than 55 kPa to preclude the possibility of gasoline coking in the injector and to suppress the amount of evaporative emission, page 7 section [0050] that suggest the RVP of 6 psi that render the instant claims obvious. The examiner takes the position that the newly added formula is an

inherent property since the oxygen proportional of the prior art is the same as the instant claims.

Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive.

Applicants makes arguments of record that the newly added formula distinguish over the prior art made of record. However, the examiner takes the position that the newly added formula is an inherent property since the oxygen proportional of the prior art is the same as the instant claims. The claims are render obvious and/or are anticipated for the reasons set forth in rejections supra because the prior art clearly teaches a fuel compositions or blends comprising organic components and oxygen compounds of the same nature and relative proportion as the instant claims. The claims as drafted are broad claims and read on the relied on prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon further teaches fuel and fuel components of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B. Medley/dh
November 17, 2003

MARGARET MEDLEY
PRIMARY EXAMINER
Margaret B. Medley